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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.   | CONFIRMATION NO. |
|--|-------------|----------------------|-----------------------|------------------|
| 10/814,079   | 03/30/2004  | Kalpana Kamath       | 01194-447001 / 02-160 | 5482             |
| 26161 7590 06/26/2009<br>FISH & RICHARDSON PC<br>P.O. BOX 1022<br>MINNEAPOLIS, MN 55440-1022 |             |                      |                       |                  |
| EXAMINER   |             |                      |                       |                  |
| PARVINI, PEGAH   |             |                      |                       |                  |
| ART UNIT   |             | PAPER NUMBER         |                       |                  |
| 1793   |             |                      |                       |                  |
| NOTIFICATION DATE  |             | DELIVERY MODE        |                       |                  |
| 06/26/2009   |             | ELECTRONIC           |                       |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

**Advisory Action  
Before the Filing of an Appeal Brief**

|                                      |                                      |
|--------------------------------------|--------------------------------------|
| <b>Application No.</b><br>10/814,079 | <b>Applicant(s)</b><br>KAMATH ET AL. |
| <b>Examiner</b><br>PEGAH PARVINI     | <b>Art Unit</b><br>1793              |

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 12 June 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because:  
a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
b) ☐ They raise the issue of new matter (see NOTE below);  
c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.  
NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 4-13 and 21-25.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_
13. ☐ Other: \_\_\_\_\_.

/Michael A Marcheschi/  
Primary Examiner, Art Unit 1793

Continuation of 3. NOTE: The amendments made to independent claim 21 would require further search and consideration .

Continuation of 11. does NOT place the application in condition for allowance because:

The Examiner acknowledges the fact that the new limitation added to claim 4 is from the cancelled claim 10 and as defined above, the amendment to the claims will not be entered due to the new issue to claim 21. However, the examiner will still comment on arguments that are in reference to claim 4

With reference to Applicants' argument that the combination of Chevallier et al. in view of Maning, the Examiner disagrees with Applicants' argument that Chevallier et al. is not reasonably pertinent to the problem with which Maning is concerned. The Examiner, respectfully, submits that Maning teaches the use of "fine" silica particles as embolic agents wherein the particles have voids (i.e. pores) while they are dispersed in a carrier fluid. Chevallier et al., as detailed previously, teach a detailed disclosure on silica particles. Considering the fact that proper motivation was detailed out on the combination of the two references, and the two are drawn to silica particles which, as a combination, would meet the recited limitations, and finally, based on the fact that Maning clearly discloses the use of fine silica particles as embolic particles, it is the examiner's position that the combination is proper. The burden is shifted on Applicants to prove, by way of tangible evidence, why the combination of the two references cannot reach the invention as claimed. It is noted that arguments cannot take the place of evidence. See MPEP 2145. Although Maning may not literally disclose all the detailed limitations of the recited claims, said reference discloses the use of "fine" silica particles, and this is seen to broadly include any and all silica particles. It is specially noted that Maning makes it clear that the choice of particle size is on the basis of the size of the vessel to be occluded, the desired duration of occlusion, the type of abnormality to be treated, and the desired microbubble size of the gas which fills the voids to make the embolic particles visible by ultrasound; in other words, Maning makes the choice of particle size obvious. Also, Maning makes the choice of particle shape obvious and in fact, disclose the spherical shape as the most preferred one. In conclusion, based on Maning, it is known and obvious to have utilized silica particles having voids, and special size depending on many factors as those recited above, and spherical shape as embolic particles. The fact that Maning may not expressly disclose the specific particle size and other characteristics of the specific silica particles recited in instant claims, does not constitute and the particles of Chevallier et al. may not be used in Maning specially based on the details yet broad characteristics of the silica particles used as embolic particles in Maning.

With reference to Applicants' argument that the Examiner has the burden of showing that Chevallier et al. inherently disclose particles with the particle pore volume and tolerance required by the claims, it is to be noted that the rejection is based on a 103(a) obviousness over a combination of references and not only based on Chevallier et al.; thus, arguments drawn to references individually are not persuasive. Furthermore, since the combination of references discloses the limitation of the silica particles in terms of shape, size, porosity and the usage, certain characteristics such as tolerance level of the particles based on their pore volume distribution is expected to follow from the silica particles of the combination of references absence evidence showing the contrary.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).